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In re Application of : DECISION ON
Bergman et al :
PCT No.: PCT/SE2003/001084 :
Application No: 10/518,961 :
Int. Filing Date: 24 June 2003 : PETITION UNDER
Priority Date: 25 June 2002 :
Attorney's Docket No.: 341058.581USPC :
For: HIGH PRESSURE PRESSING DEVICE :
AND METHOD : 37 CFR 1.47(a)

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 09 January 2005. The petition fee of \$200.00 has been paid by check.

BACKGROUND

On 24 June 2003, petitioner filed international application PCT/SE2003/001084, which claimed priority to an earlier application filed 25 June 2002. A copy of the international application was communicated by the International Bureau to the United States Patent and Trademark Office on 31 December 2003. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 25 December 2004.

On 20 December 2004, petitioner filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed declaration or oath was submitted at such time.

On 08 June 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by the International application number and international filing date." The notice indicated that the items must be submitted within two months from date of mailing or by 32 months from the priority date of the application, in order to avoid abandonment of the national stage application.

On 08 December 2005, petitioner filed the present petition in support of filing an executed declaration on behalf of omitted inventor Carl Bergman accompanied, inter alia, a declaration of Mr. Hjalt, and executed declaration without the signature of Carl Bergman.

DISCUSSION

PETITION UNDER 37 CFR 1.47(a):

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that

conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1) and (3) - (4) of 37 CFR 1.47(a) but not requirement (2).

Regarding requirement (1), petitioner has provided the complete fee of \$200.00 under 37 CFR 1.17(g).

Regarding requirement (2), in this case, it has been sufficiently demonstrated that a copy of the application papers were mailed to the non-signing inventor, Mr. Carl Bergmann but it is not clear what papers were received by Bergman and what was indicated in the letters. Although documentary evidence to support this assertion has been provided such as the cover letters, the letters are in a foreign language and no English translation has been provided. Also, the declaration of Mr. Hjalt states that Mr. Bergmann received the papers as confirmed by his telephone conversation with him but no postal receipt showing the mailing has been provided. In addition, although the date is given of the refusal, the approximated time of the conversation has not been provided.

Accordingly, it is unclear what is said in the letters and the circumstance of the refusal has not been clearly elaborate.

Regarding requirement 3, petitioner has provided a statement of the last known address of the missing inventor.

Regarding requirement 4, petitioner has provided an executed declaration signed by Mats Gardin on his behalf and on the behalf of the nonsigning joint inventor Carl Bergman.

Consequently, the current record does not sufficiently establish Bergman's refusal to join in the application because no evidentiary documents have been submitted in English to show that a *bona fide* attempt was made to deliver the complete application to him or a complete description of the oral refusal during the telephone conversation including the approximate time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in **ABANDONMENT**.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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